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**SEP 13 2006**

**OFFICE OF PETITIONS**

In re Application of :  
Qi Xiang et al. :  
Application No. 10/755,602 : **ON PETITION**  
Filed: January 12, 2004 :  
Attorney Docket No: 039153-0693(H1718) :

This is a decision on the petition under 37 CFR 1.47(a) filed August 4, 2006, which is being treated as a petition under 37 CFR 1.183 seeking waiver of 37 CFR § 1.131 where it requires that an affidavit be executed by the named inventors.<sup>1</sup>

The petition under 37 CFR 1.183 is **GRANTED**.

The above-identified application was filed on January 12, 2004. At the time of filing, applicant submitted a 37 CFR 1.63 declaration signed by all of the inventors. A non-final Office action was mailed on April 6, 2006. This office action set a shortened statutory period for reply of three months.

In response, on June 16, 2005, with a one month extension of time, applicant submitted a reply and a declaration under 37 CFR 1.131. The 37 CFR 1.131 declaration stated that all of the inventors were responsible for reduction to practice of the subject matter of the rejected claims prior to the date of the reference on which the April 6, 2006 rejection was based. However, the 37 CFR 1.131 declaration was signed by all joint inventors except joint inventor Qi Xiang. Applicant has filed the instant petition to have the 37 CFR 1.131 declaration entered despite the fact that the declaration was not signed by joint inventor Xiang.

37 CFR 1.131 states, in pertinent part:

When any claim of an application or a patent under reexamination is rejected, the **inventor** of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based.<sup>2</sup>

In addition, the Manual of Patent Examining Procedure states that "an application or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter

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<sup>1</sup> Once an application has received a fully executed oath or declaration and been placed on the files for examination, the provisions of 37 CFR 1.47 no longer apply.

<sup>2</sup> 37 CFR 1.131(a) (emphasis added).

of the claim or claims under rejection."<sup>3</sup>

Here, there has not been a party qualified under 37 CFR 1.42, 1.43, or 1.47. In addition, the instant application is not the subject of a patent under reexamination. Moreover, it has not been shown that less than all of the named inventors of the application invented the subject matter of the claims under rejection. Accordingly, the only party eligible to sign the 37 CFR 1.131 declaration are all of the joint inventors including Xiang.

The petition bears proof that the declaration was mailed to Mr. Xiang at his last known address but in spite of the effort to have it executed, Mr. Xiang has failed to comply with the request.

In order for a petition under 37 CFR 1.183 to be granted, petitioner must demonstrate that this is an extraordinary situation where justice requires waiver of the rules.

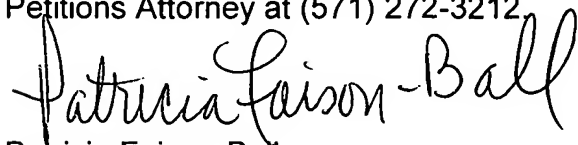
The 37 CFR 1.131 declaration was required to be signed by all joint inventors but all except joint inventor Xiang have executed it. Applicant has demonstrated that a *bona fide* effort was made to have Mr. Xiang execute the declaration. Accordingly, it is concluded that petitioner has demonstrated that this is an extraordinary situation requiring waiver of the rules.

**The 37 CFR 1.131 declaration will be entered, despite the fact that its requirement that all of the inventors sign the declaration has not been satisfied.**

It should be noted however, that effective November 22, 2004, the fee for a petition to waive the rules has been increased to \$400.00. Therein, deposit account no. 06-1447 has been charged in the amount of \$270.00 pursuant to 37 CFR 1.17(f), to make up the difference between that which was paid and that which was due. See the Notice published in the Federal Register on September 21, 2004 and in the Official Gazette of the United States Patent and Trademark Office on October 12, 2004.

The application file is being forwarded to Technology Center 2813 for consideration of the reply and the 37 CFR 1.131 declaration, filed August 4, 2006.

Telephone inquiries related to this decision should be directed to the undersigned Petitions Attorney at (571) 272-3212.

A handwritten signature in black ink that reads "Patricia Faison-Ball". The signature is written in a cursive, flowing style.

Patricia Faison-Ball  
Senior Petitions Attorney  
Office of Petitions